

RESPONSE

This is a response to the Office Action dated December 9, 2004. Claims 1-18 are pending in the application and stand rejected.

Summary of Examiner's Action and Response

The Examiner rejected Claims 1-4, 6, 7 and 9-11 under 35 U.S.C. §103(a) as being unpatentable over McSherdon (U.S. 6,220,525) in view of Rojas et al. (U.S. 6,773,727). The Applicant has reviewed these prior art references, and the rejection is respectfully traversed.

The Examiner rejected Claims 5, 8, 10 and 12-18 under 35 U.S.C. §103(a) as being unpatentable over McSherdon (U.S. 6,220,525) in view of Rojas et al. (U.S. 6,773,727) and further in view of Restive (5,881,493). The Applicant has reviewed these prior art references, and the rejection is respectfully traversed.

It is axiomatic that the prior art to be considered under section 103 must be analyzed in the absence of any teaching from the claimed invention. Such an evaluation requires the often difficult task of excluding anything taught or suggested by the present invention from one's mind. *Loctite Corp. v. Ultraseal Ltd.*, 781 F.2d 861 (Fed.Cir.1985).

In the abstract, this proposition is straightforward. However, courts have often struggled in applying it to relatively simple inventions. This is true because a relatively simple invention - once revealed by its creator - is easily understood. Thereafter, one is prone "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed.Cir. 983).

The United States Court of Appeals for the Federal Circuit recently discussed this issue in the case of *In Re Dembiczak*, 175 F.3d 994 (Fed.Cir. 2000), *limited on other grounds by In Re Gartside*, 203 F.3d 1305 (Fed.Cir.2000). *Dembiczak* involved a patent claim on the now-familiar orange trash bags with the printed Jack-O-Lantern faces.

The Dembiczak patent application was rejected by the U.S.P.T.O., then rejected by the Board of Patent Appeals and Interferences. In reversing these decisions, the Federal Circuit noted that “[T]he best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.” *Id.* at 999.

The evidence of a suggestion, teaching, or motivation to combine prior art references must be established in order to set forth a prima facie case of obviousness. *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 297 (Fed.Cir.1985). This evidence must come from the prior art references themselves, the knowledge of one who is skilled in the art, or from the suggestions inherent in the nature of a problem to be solved. *ProMold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573 (Fed.Cir.1996). The suggestion of combination generally comes from the teachings within the references themselves. *In Re Rouffet*, 149 F.3d 1350, 1359 (Fed.Cir.1998).

The Applicant respectfully submits that the requirements for a prima facie case of obviousness have not been established in this case. Instead, the Applicant suggests that the P.T.O has fallen into the trap the *Dembiczak* opinion warns so sternly against - that of using the inventor's own disclosure to suggest combinations in order to defeat patentability. With the cited authority in mind, the application of section 103 to the various claims will now be discussed in detail.

McSherdon and Rojas et al.

A prior art reference does not create a case of prima facie obviousness if it fails to disclose a material element or limitation claimed in the present invention. *In re Evanega*, 829 F.2d 1110 (Fed. Cir. 1987). Applicant respectfully submits that the prior art does not include all material elements of limitations claimed in the present invention.

In regards to Claim 1, neither McSherdon or Rojas teach the use of anhydrous borax. The Examiner cited that Rojas teaches the use of boric acid (col. 17, lines 35-39). Boric acid (H_3BO_3) is a different chemical than anhydrous borax ($Na_2B_4O_7$). Even more significant, Rojas does not teach the method step of claim 1 “providing a first mixture of solid diatomaceous earth and anhydrous borax” (emphasis added). Rojas may teach the use of boric acid and diatomaceous earth separately, but does not teach using the two in mixture.

Furthermore, the Federal Circuit has held that a suggested modification to a reference which destroys the intent, purpose, or function of the invention disclosed in the reference (NOT the invention which forms the subject of the application) does not establish a case of prima facie obviousness. This is true because, in such a case, there would be no motivation to modify the prior art reference in the fashion proposed by the Examiner. *In re Gordon*, 733 F.2d 900 (Fed.Cir. 1984). The Examiner stated that it would have been obvious to combine the insecticide mixture of Rojas with the carrier fluid and injector of McSherdon.

The first mixture of solid diatomaceous earth and anhydrous borax is a solid mixture. Applicant respectfully submits that it would not be obvious to use this insecticide mixture in place of the insecticide mixture taught by McSherdon because the apparatus would not work. McSherdon's specification provides “The top plate 28 is threadably detachable from the housing 26 for filling the housing 26 with a

concentrated formula fluid, such as an insecticide or other liquid to be dispensed” (McSherdon, column 3, lines 1-4, emphasis added). McSherdon’s specification continues “As water flows through the conduit, insecticide is aspirated from the housing 26 into the conduit 40 according to Bernoulli’s principle of fluid dynamics” (column 3, lines 17-20). McSherdon’s device would therefore not result in the mixture of solid insecticide with the carrier fluid as claimed in Applicant’s claim 1.

Since Claims 2-18 are also dependent on Claim 1, they should also be allowed. Additionally, Applicant submits independent bases for allowance of the dependent claims below.

With regards to Claim 2, Rojas does not teach using glass particles as part of a mixture with diatomaceous earth and anhydrous borax.

With regards to claims 3, 6 and 7, Rojas does not teach using metal filings as part of a mixture with diatomaceous earth and anhydrous borax.

With regards to claims 4, 9 and 11, Rojas does not teach using vegetable oil as part of a mixture with diatomaceous earth and anhydrous borax.

McSherdon, Rojas, and Restive

Restive teaches the use of Pyrethrin with as part of a mixture with a foam, but does not teach the use of Pyrethrin in a mixture with diatomaceous earth and anhydrous borax. Accordingly this is not the same as the limitation recited by the Applicant for “providing a first mixture of solid diatomaceous earth and anhydrous borax” where the “first mixture further comprises Pyrethrin.”

Conclusion

In view of the above remarks, the Applicant believes that the claims are in condition for

allowance. Accordingly, the Applicant respectfully requests that the Examiner reconsider the rejections.

Respectfully submitted this 7th day of MARCH, 2005.



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